



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/700,354 | 11/13/2000 | Tetsuya Gatanaga | IRVN-007CIP2 | 4815 |

7590 03/15/2002
Bozicevic Field & Francis
Suite 200
200 Middlefield Road
Menlo Park, CA 94025

EXAMINER

MURPHY, JOSEPH F

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1646

DATE MAILED: 03/15/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/700,354

Applicant(s)

GATANAGA ET AL.

Examiner

Joseph F Murphy

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 37-56 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1646

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Groups I-XVI, claim(s) 37-41, 54-56, drawn to an isolated polypeptide comprising the amino acid sequence encoded by the nucleic acid sequence as set forth in ONE of the following: SEQ ID NO: 1-10, 147-149, 151, 153-154.

Groups XVII-XXIII, claim(s) 42-43, drawn to a method of producing a polypeptide comprising the amino acid sequence encoded by the nucleic acid sequence as set forth in ONE of the following: SEQ ID NO: 8,9, 1-3, 5-6 or 10.

Group XXIV-XXXII, claim(s) 44, drawn to an isolated antibody specific for a polypeptide comprising the amino acid sequence encoded by the nucleic acid sequence as set forth in ONE of the following: SEQ ID NO: 8,9, 1-3, 5-6 or 10.

Group XXXIII-XL, claim(s) 45, drawn to a method of producing an antibody specific for a polypeptide comprising the amino acid sequence encoded by the nucleic acid sequence as set forth in ONE of the following: SEQ ID NO: 8,9, 1-3, 5-6 or 10.

Group XLI-LI, claim(s) 46-47, 49 drawn to an assay method for determining altered TRRE activity in a cell or tissue sample comprising contacting the sample with a polynucleotide as set forth in ONE of the following: SEQ ID NO: 1-10.

Group LII-LIX, claim(s) 48, 51, drawn to a method for determining altered expression of a modulator of TRRE activity comprising contacting a sample with an antibody specific for a polypeptide comprising the amino acid sequence encoded by the nucleic acid sequence as set forth in ONE of the following: SEQ ID NO: 8,9, 1-3, 5-6 or 10.

Group LX-LXX, claim(s) 50, 52, drawn to a method for decreasing signal transduction from a cytokine into a cell comprising contacting the cell with a polypeptide having the amino acid

Art Unit: 1646

sequence encoded by the nucleic acid sequence as set forth in ONE of the following: SEQ ID NO: 1-10.

Group LXXI, claim(s) 53, drawn to a method of screening polynucleotides for an ability to modulate TRRE activity.

The inventions listed as Groups I-LXXI do not meet the requirements for Unity of Invention for the following reasons:

Groups (I-XVI) and (XXIV-XXXII) are drawn to separate, distinct inventions and are distinguished from each other because the special technical features which define them by chemical and physical characteristics i.e. structure/function, as well as biological functions are different and these special technical features are not shared by each invention. Since these special technical features are not shared by each product and since the common features do not establish an advance over the prior art, the inventions of Groups (I-XVI) and (XXIV-XXXII) do not form a single inventive concept within the meaning of Rule 13.2

Groups (XVII-XXIII), (XXXIII-XL), (XLI-LI), (LII-LIX), (LX-LXX) and LXXI are drawn to methods different in design and performance, and which do not share the same or a corresponding special technical feature which define the contribution of each invention. The methods of Groups (XVII-XXIII), (XXXIII-XL), (XLI-LI), (LII-LIX), (LX-LXX) and LXXI do not share a corresponding special technical feature because the methods are practiced with materially different process steps for materially different purposes and each method requires different starting materials, process steps and goals. Since these special technical features are not shared by each process, and since the common features do not establish an advance over the prior art, the inventions of Groups (XVII-XXIII), (XXXIII-XL), (XLI-LI), (LII-LIX), (LX-LXX) and LXXI do not form a single inventive concept within the meaning of Rule 13.2.

Art Unit: 1646

The invention of Groups (XXIV-XXXII) is separate and distinct from the invention of Groups (LII-LIX) because the invention of Group (XXIV-XXXII) may be used in other methods than those of Group (LII-LIX), such as in the purification of protein.

The invention of Groups (I-XVI) is separate and distinct from the invention of Groups (LX-LXX) because the invention of Groups (I-XVI) may be used in other methods than those of Groups (LX-LXX), such as in the production of antibody.

The invention of Groups (I-XVI) is separate and distinct from the invention of Groups (XVII-XXIII) because the invention of Groups (I-XVI) may be produced by other methods than those of Groups (XVII-XXIII), such as by peptide synthesis.

The invention of Groups (I-XVI) is separate and distinct from the inventions of Groups (XLI-LI), (LII-LIX), (LXXI) because the invention of Groups (I-XVI) is not used or produced by the inventions of Groups (XLI-LI), (LII-LIX), (LXXI).

The invention of Groups (XXIV-XXII) is separate and distinct from the inventions of Groups (XVII-XXIII), (XLI-LI), (LX-LXX), (LXXI) because the invention of Groups (XXIV-XXII) is not used or produced by the inventions of Groups (XVII-XXIII), (XLI-LI), (LX-LXX), (LXXI).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

Art Unit: 1646

application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Joseph F. Murphy, Ph. D.
Patent Examiner
Art Unit 1646
March 11, 2002

David S. Romeo
DAVID S. ROMEO
PRIMARY EXAMINER